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10/728,160	12/04/2003	Puthukode G. Ramachandran	AUS920030976US1	6788
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IBM CORP (YA)			EXAMINER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/728,160

**Applicant(s)**RAMACHANDRAN, PUTHUKODE  
G.**Examiner**

Jinhee J. Lee

**Art Unit**

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                                                                                                                                                        |                                                                                                                                                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claims 9-20, claims 9-20 still fails to fall within a statutory category of invention. It is directed to a programmed functionality of a system or computer program product, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter. Therefore, it's non-statutory under 32 USC 101.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Saylor et al. (20020186238).

Re claim 1, Saylor et al. discloses a method in a data processing system for managing display of a new document, the method comprising data processing system implemented steps of:

Displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows (see paragraph 0152 and 0177, title bar for example); and

Replacing, in response to a user selection of a browser window from the list of browser windows, a document displayed in the browser window with the new document (see paragraph 0177 and figure 6B for example).

Re claim 2, Saylor et al. discloses a method further comprising: promoting the browser window to a top of a window hierarchy (see paragraph 0177 and 0152 for example).

Re claim 3, Saylor et al. discloses a method, wherein the indication is a document name from a title bar (see paragraph 0101 for example).

Re claim 4, Saylor et al. discloses a method, wherein the indication is a thumbnail of the document (see paragraph 0102 for example).

Re claim 5, Saylor et al. discloses a method, wherein the list of browser windows, including the indication of the presently displayed document in each respective browser

window in the list of browser windows (recent lists, see paragraph 0152 for example), is displayed in a pop-up menu (see paragraph 0152, 0177 and figure 6b for example).

Re claim 6, Saylor et al. discloses a method, wherein the receiving step and the replacing step are performed by a Web browser (see paragraph 0152, 0177 and figure 6b for example).

Re claim 7, Saylor et al. discloses a method, wherein the new document is selected from one of a Web page, an image, or a spreadsheet (see paragraph 0152, 0177 and figure 6b for example).

Re claim 8, Saylor et al. discloses a method, wherein the user input is received in a currently active browser window (see paragraph 0152, 0177 and figure 6b for example).

Re claim 9, Saylor et al. discloses a data processing system for managing display of a new document, the data processing system comprising:

displaying means, responsive to receiving a user input indicating that the new document is to be displayed, for displaying on a display of the data processing system a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows; and

replacing means, responsive to a user selection of a browser window from the list of browser windows, for replacing a document displayed in the browser window with the new document (see paragraph 0152, 0177 and figure 6b for example).

Re claim 10, Saylor et al. discloses a data processing system further comprising: promoting means for promoting the browser window to a top of a window hierarchy (see paragraph 0152, 0177 and figure 6b for example).

Re claim 11, Saylor et al. discloses a data processing system, wherein the indication is a document name from a title bar (see paragraph 0152, 0177 and figure 6b for example).

Re claim 12, Saylor et al. discloses a data processing system, wherein the indication is a thumbnail of the document (see paragraph 0152, 0177 and figure 6b for example).

Re claim 13, Saylor et al. discloses a data processing system, wherein the list of browser windows, including the indication of the presently displayed document in each respective browser window in the list of browser windows (recent list, see paragraph 0152 for example), is displayed in a pop-up menu (see paragraph 0152, 0177 and figure 6b for example).

Re claim 14, Saylor et al. discloses a data processing system, wherein the receiving means and the replacing means are performed by a Web browser (see paragraph 0152, 0177 and figure 6b for example).

Re claim 15, Saylor et al. discloses a computer program product comprising: first instructions, responsive to receiving a user input indicating that the new document is to be displayed, for displaying a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows(see figure 6b with 519 for example); and

second instructions, responsive to a user selection of a browser window from the list of browser windows, for replacing a document displayed in the browser window with the new document (see figure 6b with 518 for example).

Re claim 16, Saylor et al. discloses a computer program product further comprising: third instructions for promoting the browser window to a top of a window hierarchy (see paragraph 0152, 0177 for example).

Re claim 17, Saylor et al. discloses a computer program product, wherein the indication is a document name from a title bar (see paragraph 0101 for example).

Re claim 18, Saylor et al. discloses a computer program product, wherein the indication is a thumbnail of the document (see paragraph 0102 for example).

Re claim 19, Saylor et al. discloses a computer program product, wherein the list of browser windows, including the indication of the presently displayed document in each respective browser window in the list of browser windows (recent list, see paragraph 0152 for example), is displayed in a pop-up menu (see paragraph 0152, 0177 and figure 6b for example).

Re claim 20, Saylor et al. discloses a computer program product, wherein the first instructions and the second instructions are performed by a Web browser (see paragraph 0152, 0177 for example).

Re claim 21, Saylor et al. discloses a data processing system comprising:

a bus system (with 635 for example);

a memory (with 634 for example) connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive a user input indicating that a new document is to be displayed, wherein a list of browser windows is displayed including an indication of a presently displayed document in each respective browser window in the list of browser windows; and replace a document displayed in the browser window with the new document in response to a user selection of a browser window from the list of browser windows(see paragraph 0152, 0177 and figure 6b for example).'

### ***Response to Arguments***

5. Applicant's arguments filed 10/24/07 have been fully considered but they are not persuasive.

In response to applicant's arguments that 101 requirements are met, examiner disagrees in regards to claims 9-20. These claims are directed to a program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter.

In response to applicant's arguments that the prior art does not teach the list of browser windows (recent list) displayed responsive to receiving a user input indicating that a new document is to be displayed and that "recent list" is not a list of browser windows, examiner disagrees. First, the applicant's inventions meaning of "new" seems to refer to a document that is different from the current document (and including the



current document) in their step of selecting "new document". Second, user's selection of a drop down window **is** a user input. Third, as seen in figure 6B, there drop down menu displays first to last "recent list" of items. Further, paragraph 0152 teaches that selecting logical hierarchy opens item in a new display window.

In response to applicant's arguments that the recent list does not include any indication of a presently displayed document, however, examiner points out that most likely the presently displayed document is the "last recent list item" or at least the indication of the presently displayed document is shown by delete item, which is indicating the reference to the presently displayed document.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-2100 ext. 74. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/  
Primary Examiner, Art Unit 2174

jjl